REMARKS

Applicant traverses the rejections of record and requests reconsideration and withdraw of such in view of the remarks and amendments contained herein. Claims 35-47 and 49-96 are pending in this application.

Rejection Under 35 U.S.C. § 112(1)

Claims 35, 47, 85, and 88 are rejected under 35 U.S.C. 112, first paragraph, as based on a disclosure which is not enabling. The Examiner states that "[d]etails critical or essential to the practice of the invention, but not included in the claims is not enabled by the disclosure", again citing *In re Mayhew*, 527 F.2d 1229, 188 U.S.P.Q. 356 (CCPA 1976) for support. As previously pointed out by the Applicant *In re Mayhew* involved elements not recited in the claim which the specification clearly recited as essential to the practice of the invention. This is clearly not the in the present application. Applicant has not recited in the specification that any mechanism for comparing a music sample is required by the invention. Applicant has recited a preferred embodiment of a mechanism for making the comparison, but has in no way indicated that it is required and the Examiner has not pointed to any such statements in the specification, as would be required under *In re Mayhew*.

Further, the claims rejected by the Examiner are drawn to "[a] method for providing a transaction to a user", and "[a] method for identifying music to a user". The claims are not drawn to a method for comparing a captured music sample against a music database, nor does the particular method of comparing a captured music sample against a music database required by the claimed subject matter. Since the details of the comparison are not dependent on the other elements of the claimed subject matter, they are not critical to the practice of the invention as argued by the Examiner. If the scope of the subject matter embraced by the claims is clear, and Applicant has not indicated that the scope of the invention is different from the defined claims, then the claims are definite. see M.P.E.P. § 2173.04.

Finally, Applicant again disagrees with the Examiner's assertion that the disclosure is not enabling. The comparison of a captured music sample against a music database is described at length in the specification. see, for example, pgs. 29-34, 41-51. The Applicant discloses a preferred embodiment of "comparing" in specification; however, the preferred

method of comparing is not necessarily the only method of comparing. As such, each claim of the in the present application is supported by an enabling disclosure as required by 35 U.S.C. 112, first paragraph. In view of the above, the Applicant respectfully submits that the claims are enabled under 35 U.S.C. 112, first paragraph, and requests withdrawal of the 35 U.S.C. § 112 rejection of record.

Rejection Under 35 U.S.C. § 102(b)

Claims 35-44 are rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,125,024 to Gokcen et al (hereinafter "Gokcen").

It is well settled that to anticipate a claim, the reference must teach every element of the claim. see M.P.E.P. § 2131. Moreover, in order for a prior art reference to be anticipatory under 35 U.S.C. § 102 with respect to a claim, "[t]he elements must be arranged as required by the claim." see M.P.E.P. § 2131; citing In re Bond, 15 U.S.P.Q.2d 1566 (Fed. Cir. 1990). Furthermore, in order for a prior art reference to be anticipatory under 35 U.S.C. § 102, "[t]he identical invention must be shown in as complete detail as is contained in the . . . claim." see M.P.E.P. § 2131; citing Richardson v. Suzuki Motor Co., 9 U.S.P.Q.2d 1913 (Fed. Cir. 1989).

Claim 35, as amended, recites a method for providing a transaction to a user exposed to a media stream, comprising receiving a signal including a captured sample of a media stream from the user, said media stream comprising music. As has been previously described by Applicant, Gokcen merely teaches receiving a user voice command at a speech recognizer that responds to the received command by prompting a voice response unit to initiate further procedures with a user. see Gokcen col. 5 line 60- col. 6 line 5. As such, Gokcen does not teach receiving a signal including a captured sample of a media stream where the media stream comprises music.

The Examiner admits that Gokcen does not teach a media stream comprising music, but instead states "official notice is hereby taken that it is obvious to one skilled in the art that since voice (an audible signal) is decipherable by Gokcen's design, that music (an audible signal) can also be decipherable by Gokcen's design, for the purpose of recognizing (audible)

customer commands (claim 1, Gokcen)." Office Action, page 3. Applicant respectfully traverses the Examiner's "official notice". Applicant is unaware of any integrated voice response (IVR) system that can identify music, and the Examiner is apparently unable to find any reference to IVR systems recognizing anything but a small set of voice commands as is described by Gokcen. Further, as will be described below with respect to Pocock, existing music identification techniques use IVR systems, but are unable to identify music from a captured sample. Applicant respectfully requests that the Examiner provide any basis for the official notice that IVR systems must be capable of recognizing music.

As Gokcen does not describe receiving a signal including a captured sample of a media stream from the user, said media stream comprising music, determining from the signal a characteristic of the captured sample and triggering a predetermined transaction with the user involving the music in response to the determined characteristic as required by claim 35, and the Examiner has provided no basis or support for the "official notice" describing these characteristics, Applicant respectfully asserts that claim 35 is not anticipated by Gokcen and is in condition for allowance.

Claims 36-44 depend from claim 35 and inherit each claim element therefrom. As such, claims 36-44 set forth elements not taught by Gokcen. Therefore, claims 36-44 are patentable at least for the reasons set forth above with respect to claim 35.

Rejection Under 35 U.S.C. § 103(a)

Claims 45-96 are rejected under 35 U.S.C. §103(a) as being unpatentable over Gokcen in view of U.S. Patent No. 5,661,787 to Pocock (hereinafter "Pocock").

To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art cited must teach or suggest all the claim elements. *See* M.P.E.P. § 2143. Without conceding that the first second criteria are satisfied, Applicant respectfully asserts that the Examiner's rejection fails to satisfy at least the third criteria.

Lack of All Claim Limitations

Claim 47 recites "receiving a signal including a captured sample of the music from the user; wherein the music is received by the user via radio broadcast and the captured sample includes a sample of the radio broadcast." The Examiner cites Gokcen as disclosing a design for a voice (captured sample) response unit used to decipher voice commands. The Examiner takes official notice that it would have been obvious to one skilled in the art to place a telephone receiver next to a radio to retrieve audible signals. As described with reference to claim 35, Gokcen does not describe captured samples of music as required by claim 47 and even the Examiner's official notice does not address this requirement. Applicant would further argue that any attempt to extend Gokcen to identifying music for a user is inappropriate and not supported by any evidence as described above with reference to claim 35.

Pocock is not relied upon as teaching a captured sample of music, and in fact teaches an entirely different mechanism for identifying music from a radio station. Pocock describes a system that allows radio broadcast users to use a telephone to connect to a database that contains prerecorded audio descriptions of material played on a radio station. Abstract. The database is indexed by the radio station's play list to allow the user to select a particular audio description of interest. Abstract. When a user hears a particular song that they want more information about, the user calls a designated telephone number advertised by the radio station which is specific to that radio station. Column 2, lines 48-63. A telephone interface provides the listener with the name of the musical artist and the song titles in the reverse order played during the broadcast, starting with the current piece played. Id. The selection, from the current artist played, to the music product the potential purchaser wants to order, is controlled by the potential purchaser using the touch tone telephone keys or voice input. Id. When the potential purchaser reaches the song and artist of interest, further details can be related such as the other songs recorded on the album, pricing, availability and delivery information. Id.

Pocock does not describe comparing a characteristic of a captured sample of music to identity records in a database. Instead Pocock relies upon the play list of the radio station indexed according to the time of the call. As neither Gokcen, nor Pocock describe capturing

a sample of music from a user, determining a characteristic of the captured sample and locating an identity record corresponding to the captured sample, the rejection of record does not describe all the limitations of claim 47 as required under §103.

Lack of Motivation

The Examiner has combined Gokcen with Pocock stating that Gokcen does not provide for a music database which can be searched to find a product match for the user. The Examiner cites Pocock as teaching a design for a phone based, music based and music related items purchasing design which allows a user to search through songs. The Examiner states that it would have been obvious to combine the teachings of Gokcen and Pocock to provide an automated transaction system to record and track radio audio segments enabling a radio listener to use their telephone to recall and preview on demand music pieces previously broadcast.

In order to combine references there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art to modify the reference or to combine reference teachings. M.P.E.P. § 2143. Applicant respectfully asserts that there is no motivation to combine Gokcen with Pocock, as Pocock already teaches using an integrated voice response (IVR) system with all the functionality of Gokcen. Gokcen's IVR system allows a user to navigate a menu using voice commands in response to a voice prompt. Abstract. Pocock describes exactly the same IVR functionality. For example, column 2, lines 56-60 describe a user interacting with the system using voice commands. Similarly, column 7, lines 10-14 describes a user inputting data to the system "by voice into a section of the telephone interface that recognizes spoken numbers and words through voice recognition.

As Pocock already describes the same functionality as Gokcen there would be no motivation to combine the references as required by § 103 and M.P.E.P. § 2143. Applicant respectfully asserts that claim 47 is, therefore, allowable over the rejection of record.

Claims 49-84 depend from claim 47 and thereby inherit each element therefrom. As shown above, the combination of Gokcen and Pocock fails to teach or suggest receiving a

signal including a captured sample of the music from the user; wherein the music is received by the user via radio broadcast and the captured sample includes a sample of the radio broadcast as recited in claim 47, nor is there any motivation in either Gokcen or Pocock to make the combination suggested by the Examiner. As such, claims 49-84 set forth elements not taught or suggested by the Examiner's proposed combination, and there is no motivation to combine the references. Therefore, claims 49-84 are patentable at least for the reasons set forth above with respect to claim 47. Applicant requests withdrawal of the 35 U.S.C. 103(a) rejection of record.

Claims 85 and 88 recite a method for identifying music to a user exposed to a broadcast that includes unidentified music, comprising receiving a signal including a captured sample of the broadcast from the user, said broadcast comprising music. As shown above with respect to claims 35 and 47, Gokcen does not teach or suggest receiving a signal including a captured sample of the broadcast from the user said broadcast comprising music as recited in claims 85 and 88. Moreover, Pocock is not relied upon to teach or suggest this missing element. As such, the Examiner's proposed combination fails to teach or suggest each element of Applicant's invention. Further, for the reasons set forth with respect to claim 47, there is no motivation to combine Pocock with Gokcen as Pocock already includes all of the functionality described by Gokcen. Therefore, Applicant requests withdrawal of the 35 U.S.C. 103(a) rejection of record.

Claims 86-87 and 89-96 depend from claims 85 and 88, respectively, and thereby inherit each element therefrom. As shown above, the combination of Gokcen and Pocock fails to teach or suggest each element of claims 85 and 88. As such, claims 86-87 and 89-96 set forth elements not taught or suggested by the Examiner's proposed combination. Therefore, claims 86-87 and 89-96 are patentable at least for the reasons set forth above with respect to claims 85 and 88. Applicant requests withdrawal of the 35 U.S.C. 103(a) rejection of record.

Conclusion

In view of the above the remarks and amendments above, Applicant believes the pending application is in condition for allowance. Applicant believes no fee is due with this response. However, if a fee is due, please charge Deposit Account No. 06-2380, under Order No. 69323/P002US/10511081 from which the undersigned is authorized to draw.

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Respectfully submitted,

By 

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